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OFFICE OF PETITIONS

DECISION ON PETITION
UNDER 37 C.F.R. §1.47(b)

In re Application of
Bruno Grendene
Application No. 09/916,650
Filed: July 30, 2001
Attorney Docket No. 1200.513
Title: METHOD AND DEVICE
FOR DETECTING THE
BLOCKING OF A STEPPER
MOTOR

This is in response to the petition under 37 CFR §1.47(b)¹, filed April 5, 2002.

The petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

¹ A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a complete copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign, or cannot be reached after diligent efforts;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

The above-identified application was filed on July 30, 2001, without an executed oath or declaration and identifying Bruno Grendene as the sole inventor. On September 7, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted", requiring an executed oath or declaration in compliance with 37 CFR §1.63, a surcharge for the late filing of the oath or declaration, and the filing fee. This Notice set a two-month period for reply.

In reply, applicant filed the original petition, along with the associated fee, the fee associated with the late filing of an oath or declaration, the filing fee, and a five-month extension of time to make timely this reply.

With the petition, the petitioner has provided the last known address of the inventor, a statement by Michel Gerrard (counsel for an entity called Valeo Climatisation, the purported assignee), a declaration executed by Mr. Gerrard, and the filing fee².

The petitioner asserts that the non-signing inventor worked for the purported assignee during the relevant period of invention, that the present application is directly related to the business of the purported assignee, and that the purported assignee has a property interest in the present application.

Rule 47 applicant has met requirements (1) – (3) above.

Regarding the fourth requirement above, nowhere is it set forth that a complete copy of the application papers was sent to the non-signing inventor for him to review. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration.³ On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁴.

² Petitioner has also submitted a copy of the non-signing inventor's employment agreement, as well as several e-mails. Unfortunately, as these documents are in French and the petitioner has failed to provide a translation, their contents cannot be discerned.

³ See MPEP 409.03(d).

⁴ *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Regarding the sixth requirement above, Rule 47 applicant has not established sufficient proprietary interest in the subject matter to justify the filing of the application. It is noted that no assignment has been filed in conjunction with this application. Furthermore, as stated above, the submitted employment agreement cannot be understood. On renewed petition, petitioner should submit a translation of this document.

Regarding the seventh requirement above, no proof of irreparable damage has been submitted.

Regarding the eighth requirement above, the submitted declaration is not in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63. It is noted that Mr. Gerrard has executed the declaration on behalf of the non-signing inventor. First, both his residence and his post office address are listed as "Valeo Climatisation". It is certainly understandable that he has listed his work address as his mailing address. However, it is less clear why the declarant has seemingly asserted that he lives in his office. Secondly, the declaration fails to list the relationship of the declarant to the non-signing inventor.⁵ Thirdly, it is noted that the citizenship of both the non-signing inventor and Mr. Gerrard is listed as "French". This should read "France". On renewed petition, the petitioner should either provide an executed oath or declaration, or one that corrects the deficiencies set forth above.

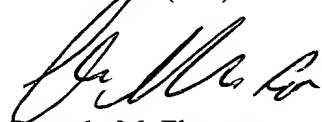
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
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By FAX: (703) 308-6916
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By hand: Crystal Plaza Four, Suite 3C23
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Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁵ See MPEP §§ 409.03(b), 409.03 (f), and 605.04(a).